

### **Remarks**

This communication is considered fully responsive to the Office Action. Claims 1-49 were examined. Claims 1-49 stand rejected. Claims 1, 2, 16-18, 30, 32-34, and 48-49 are amended. Claim 15 is canceled. No new claims have been added. Reexamination and reconsideration of the pending claims are respectfully requested.

### **Claim Rejections - 35 U.S.C. 112**

The Office Action rejected claim 2 under 35 U.S.C. 112, second paragraph, as improperly depending from itself. Claim 2 is amended to depend from claim 1. Applicant appreciates the examiner noting this typographical error in the original application.

### **Claim Rejections - 35 U.S.C. 102(b) - Takahashi**

The Office Action rejected claims 1, 2, 9, 14, 18, 19, 25, 26, 30, 34, 35, and 43 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication No. 2001/0040684 to Takahashi ("Takahashi"). Applicant respectfully traverses this rejection.

Claim 1 is amended to recite "A digital camera, comprising a user interface receiving specification of an arbitrary aspect ratio from a user at which to produce a digital photograph taken by the camera, the arbitrary aspect ratio indicating a standard photographic print format." Takahashi fails to disclose at least these recitations.

When similar recitations were previously included in claim 15, the Office Action instead stated that these recitations are *inherent* based on the disclosure in Figures 1 and 29-30; col. 13, lines 1-11; and col. 14, lines 9-17 in U.S. Patent No. 5,724,579 to Suzuki (“Suzuki”).

By relying on inherency, the Office Action is admitting that the claim recitations are not expressly shown in the cited references. Applicant agrees with this admission. However, the Office Action erroneously relied on inherency as the only evidence for rejecting these recitations. Applicant respectfully traverses this position.

In order to support a rejection based upon the inherent limitations that are not expressly disclosed in a prior art reference, more than a summary statement that the recitations are inherent is required. It must be shown that the undisclosed information was known by those of ordinary skill in the art to be present in the reference. *Rosco, Inc. v. Mirror Light Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002).

Applicant contends that the claim recitations are not inherent in the cited references or otherwise considered common knowledge to those having ordinary skill in the art. Figure 1 in Suzuki shows a block diagram representing implementation of an image processing apparatus, such as a digital still camera. Figure 1 shows no component which would inherently disclose specification of an arbitrary aspect ratio from a user. Suzuki is concerned with extracting a portion of image data of a predetermined image area to improve retrieval speed, e.g., by only retrieving the desired image data. See, e.g., Abstract and Summary of Invention in Suzuki. To that extent, Figures 29 and 30 illustrate a

selection area and a subordinate area, wherein the subordinate area is the selection area. Suzuki at col. 13, lines 1-11 and col. 14, lines 9-17 also disclose an area selection mode for selecting these subordinate images so that the entire image data does not need to be transferred. However, there is no disclosure in Suzuki directed to specification of an arbitrary aspect ratio by a user. Hence there is no inherent disclosure of specification of an arbitrary aspect ratio from a user.

If this rejection is maintained on a similar basis in a subsequent action, Applicant respectfully requests the Examiner provide affidavit evidence beyond a mere conclusionary statement to support this modification of the cited reference. “When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee. . . .” 37 CFR §1.104(d)(2).

Claim 1 is also amended to recite “a preview mode display showing only the portions of a scene within the specified arbitrary aspect ratio by cropping a resulting final photograph to the specified arbitrary aspect ratio.” Applicant cannot find any support in Suzuki, express or inherent, to maintain a rejection of these recitations in claim 1.

For at least the foregoing reasons claim 1 as amended is believed to be allowable over the cited references and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 2, 9, 14 depend from claim 1, which is believed to be allowable. Therefore, claims 2, 9, 14 are also believed to be allowable for at least the same reasons as claim 1. Withdrawal of the rejection of claims 2, 9, 14 is respectfully requested.

Claim 18 is amended to include similar recitations as claim 1. Therefore claim 18 is also believed to be allowable for the reasons discussed above and withdrawal of the rejection of claim 18 is respectfully requested.

Claims 19, 25, 26 depend from claim 18, which is believed to be allowable. Therefore, claims 19, 25, 26 are also believed to be allowable for at least the same reasons as claim 18. Withdrawal of the rejection of claims 19, 25, 26 is respectfully requested.

Claims 30 and 34 are amended to include similar recitations as claim 1. Therefore claims 30 and 34 are also believed to be allowable for the reasons discussed above and withdrawal of the rejection of claims 30 and 34 is respectfully requested.

Claims 35 and 43 depend from claim 34, which is believed to be allowable. Therefore, claims 35 and 43 are also believed to be allowable for at least the same reasons as claim 34. Withdrawal of the rejection of claims 35 and 43 is respectfully requested.

**Claim Rejections - 35 U.S.C. 102(b) - Suzuki**

The Office Action rejected claims 15, 27, 31, and 47 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication No. 2001/0040684 to Takahashi ("Takahashi"). Applicant respectfully traverses this rejection.

Claim 15 is canceled and therefore the rejection is moot. Claims 27, 31, and 47 include similar recitations as claim 1 and are believed to be allowable over Suzuki as discussed above. Withdrawal of the rejection of claims 15, 27, 31, and 47 is respectfully requested.

**Claim Rejections - 35 U.S.C. 103(a) - Takahashi**

The Office Action rejected claims 10-13 and 44-46 under 35 U.S.C. 103(a) as being unpatentable over Takahashi. Applicant respectfully traverses this rejection.

Claims 10-13 depend from claim 1 and claims 44-46 depend from claim 34. Claims 1 and 34 are believed to be allowable for the reasons discussed above. Applicant does not see how an obviousness rejection can account for the missing recitations discussed above. Therefore, claims 10-13 and 44-46 and are also believed to be allowable.

In addition, claim 13 recites “wherein the aspect ratio specification occurs before the digital photograph is taken.” The Office Action relies on a combination of Official Notice and obviousness as disclosing these recitations. Not only are these recitations not included in the cited references, and hence the examiner’s reliance on Official Notice, but it would not even be inherent in the references, leaving the Office Action to additionally rely on obviousness. Furthermore, if the Office Action were to maintain this rejection based on the amendments to claim 1, the rejection would have to rely on inherency, Official Notice, and obviousness to reject a single claim! Applicant respectfully asserts

that not only would such an approach to a rejection be tenuous at best, it would be outright error to maintain a rejection on this basis.

Furthermore, Applicant hereby challenges the factual assertion as not properly officially noticed or not properly based upon common knowledge. As such, Applicant asks the Examiner to provide adequate **documentary evidence**. MPEP § 2144.03.

Applicant contends that the noticed fact is not considered common knowledge or well-known in the art. Specifically, if such a rejection were to be maintained by applying Suzuki, Suzuki expressly teaches against such a conclusion. That is, Suzuki discloses first producing a subordinate image, and then producing a second subordinate image by extracting part of the image data of the first subordinate image produced by the first subordinate image producing means. See, e.g., Abstract in Suzuki. Accordingly, Suzuki expressly teaches that the camera has to take an image first before selecting parameters relating to that image.

Furthermore, the facts relied on for Official Notice may only serve to ‘fill the gaps’ which might exist in the evidentiary showing - not comprise the principle evidence upon which a rejection is based. MPEP § 2144.03. The Office Action erroneously relied on official notice as the only evidence for rejecting the recitations of claim 13.

In light of Applicant’s traversal, Applicant respectfully asks the Examiner to produce authority (in the form of documentary evidence) for the alleged notice if such a rejection is maintained in a subsequent Office Action.

Withdrawal of the rejection of claims 10-13 and 44-46 is respectfully requested for at least these reasons.

**Claim Rejections - 35 U.S.C. 103(a) – Suzuki**

The Office Action rejected claims 16-17, 28-29, 32-33, and 48-49 under 35 U.S.C. 103(a) as being unpatentable over Suzuki. Applicant respectfully traverses this rejection.

Claims 16-17, 28-29, 32-33, and 48-49 depend from independent claims 1, 27, 31, and 47, respectfully. Each of the independent claims is believed to be allowable for the reasons discussed above. Applicant does not see how an obviousness rejection can account for the missing recitations discussed above. Therefore, claims 16-17, 28-29, 32-33, and 48-49 are also believed to be allowable.

In addition, claim 16 recites “wherein the arbitrary aspect ratio is specified by a numerical value.” Claims 28, 32, and 48 include similar recitations. Claim 17 recites “wherein the arbitrary aspect ratio is specified by specifying a width and a height for the photograph.” Claims 29, 33, and 49 include similar recitations. Here again, the Examiner is unable to find support in the prior art and relies on Official Notice in combination with obviousness to reject these recitations.

Applicant challenges the factual assertion as not properly officially noticed or not properly based upon common knowledge for the reasons discussed above with reference to claim 13. If the recitations are well known in the art, as contended by the Examiner, then it should be readily available in the

form of a reference. As such, Applicant asks the Examiner to provide adequate **documentary evidence** if such a rejection is maintained in a subsequent Office Action. MPEP § 2144.03.

**Claim Rejections - 35 U.S.C. 103(a) – Takahashi and Sakamoto**

The Office Action rejected claims 3-7, 20-24, 36-40, and 41 under 35 U.S.C. 103(a) as being unpatentable over Takahashi and further in view of Sakamoto. Applicant respectfully traverses this rejection.

Claims 3-7, 20-24, 36-40, and 41 depend from independent claims 1, 18, and 34, respectfully. Each of the independent claims is believed to be allowable for the reasons discussed above. Applicant does not see how an obviousness rejection can account for the missing recitations discussed above. Therefore, claims 3-7, 20-24, 36-40, and 41 are also believed to be allowable.

**Claim Rejections - 35 U.S.C. 103(a) – Takahashi and Suzuki**

The Office Action rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Takahashi and further in view of Suzuki. Applicant respectfully traverses this rejection.

Claim 8 depends from independent claims 1, which is believed to be allowable for the reasons discussed above. Applicant does not see how an obviousness rejection can account for the missing recitations discussed above. Therefore, claim 8 is also believed to be allowable.



**Claim Rejections - 35 U.S.C. 103(a) – Takahashi and Suzuki**

The Office Action rejected claim 42 under 35 U.S.C. 103(a) as being unpatentable over Takahashi and further in view of Suzuki. Applicant respectfully traverses this rejection.

Claim 42 depends from independent claims 34, which is believed to be allowable for the reasons discussed above. Applicant does not see how an obviousness rejection can account for the missing recitations discussed above. Therefore, claim 42 is also believed to be allowable.

**Conclusion**

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

/Mark D. Trenner/

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By: \_\_\_\_\_

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